

ESTTA Tracking number: **ESTTA431025**

Filing date: **09/18/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	EricJ.Figueroa
Granted to Date of previous extension	10/01/2011
Address	18220 NE 25 Place Aventura, FL 33160 UNITED STATES
Correspondence information	EricJ.Figueroa CEO Yeah Baby Inc. 18220 NE 25 Place Aventura, FL 33160 UNITED STATES ericjfigueroa@hotmail.com Phone:305-300-4583

### Applicant Information

Application No	85216162	Publication date	08/02/2011
Opposition Filing Date	09/18/2011	Opposition Period Ends	10/01/2011
Applicant	Shaw & Partners, LLC 4701 Liberty St Kansas City, MO 64112 UNITED STATES		

### Goods/Services Affected by Opposition

Class 035. First Use: 2010/10/30 First Use In Commerce: 2010/11/15  
All goods and services in the class are opposed, namely: Advertising and marketing services, namely, promoting the goods and services of others

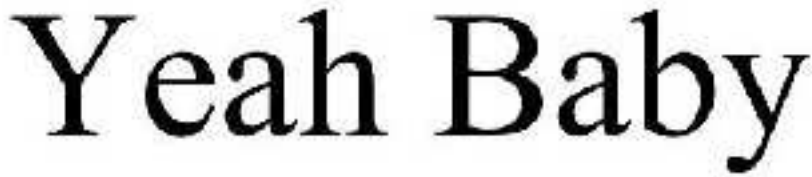
### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Priority and likelihood of confusion and non-use of an alleged use in commerce trademark

### Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	85113059	Application Date	08/22/2010
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	YEAH BABY
Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 035. First use:</p> <p>Advertising and marketing services, namely, promoting the goods and services of third parties through print, audio, video, digital and on-line medium in the agricultural, aircraft, airline, apparel, appliance, automobile, banking, book, business, computer, construction, cosmetic, educational, electrical, electronics, energy, engineering, environmental, financial, food, hardware, health, insurance, internet, investment, legal, machinery, management, manufacturing, media, medical, news, office, pharmaceutical, real estate, retail, shipping, software, technology, telecommunications, textile, transportation and travel fields, not including any baby products or services</p>

U.S. Application No.	85349574	Application Date	06/17/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	YEAH BABY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2010/08/22 First Use In Commerce: 2010/08/22</p> <p>Advertising agencies, namely, promoting the goods and services of others; Advertising and marketing services, namely, promoting the goods and services of others; Advertising and publicity services, namely, promoting the goods, services, brand identity and commercial information and news of third parties through print, audio, video, digital and on-line medium</p>		

Attachments	85113059#TMSN.jpeg ( 1 page )( bytes ) 85349574#TMSN.jpeg ( 1 page )( bytes )
-------------	--

	Notice of Opposition.pdf ( 2 pages )(793124 bytes )
--	---

## **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Facsimile or email (by agreement only) on this date.

Signature	/Eric J. Figueroa/
Name	EricJ.Figueroa
Date	09/18/2011

September 18, 2011

### **Notice of Opposition**

I am requesting that the applicants mark be refused based on, non-use of an alleged use in commerce trademark, my prior use and use in commerce trademark and likelihood of confusion.

I am opposing the applicants mark, Yeah, SN/85216162

My trademark and applications are, Yeah Baby, SN/85113059(filed 8/22/2011) and SN/85349574(first use and first use in commerce is 8/22/2010)

The applicant has alleged, use in commerce, of a trademark for which he clearly had not used. The applicants trademark should have been refused for non-use of an alleged, use in commerce trademark, while providing class 25 specimens, three times and claiming a 1a filing basis for class 35, advertising and marketing services. It is evident from the three class 25 specimens, that the applicant never had a 1a filing basis for advertising and marketing services. The applicant did not use the mark in commerce on or in connection with services. The intent of the applicant was to trademark goods, not services. The applicant tried to amend the trademark application from, delete class 35 services, to, add class 25 goods on 4/28/2011. The applicant has recently applied for a class 25 trademark. The applicants alleged first use and first use in commerce dates are 10/30/2010 and 11/15/2010. The applicants fourth specimen was the first specimen to be approved after the third office action by the examining attorney. The applicants trademark should have been refused on 3/31/2011 for non-use of an alleged, use in commerce trademark. The applicants trademark should be null, void and refused for non-use of an alleged, use in commerce trademark.

In the first Office Action dated 3/31/2011, under, search results, it states, "The trademark examining attorney has searched the office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d)". The applicants trademark should have been refused on 3/31/2011 for likelihood of confusion. The applicants trademark should be refused for likelihood of confusion.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks for similarities in appearance, sound, connotation and commercial impression. Similarity in any one of these elements is sufficient to find a likelihood of confusion. Second, the examining attorney must compare the services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely.

The marks are similar and almost identical because they contain the word, Yeah. The applicant has merely deleted wording from my trademark, Yeah Baby. The mere deletion of wording from a trademark is not sufficient to overcome a likelihood of confusion for competing, advertising and marketing services. See *In re Optical Int'l*, 196 USPQ 775 (TTAB 1977) (where applicant filed to register the mark OPTIQUE for optical wear. Deletion of the word BOUTIQUE is insufficient to distinguish the mark, OPTIQUE, from the mark, OPTIQUE BOUTIQUE, when used in connection with competing optical wear). In this case, the mark, Yeah, does not create a distinct commercial impression because it contains the same dominant and common wording and there is no other wording to distinguish it from my trademark, Yeah Baby. The word in a mark may be more significant in creating a commercial impression and suggests that it originates from a single source. Greater weight is given to the dominant word in determining whether there is a likelihood of confusion. The dominant portion of the marks is identical and the marks are highly similar and their commercial impression is confusingly similar.

It is sufficient that the advertising and marketing services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers and believe that the advertising and marketing services come from the same source and will cause confusion, mistake and deception.

The marks are similar and the advertising and marketing services are related in some manner. Because of the similarities between the marks and the related services, a likelihood of confusion exists.

Thank You,

A handwritten signature in cursive script, reading "Eric J. Figueroa". The signature is fluid and stylized, with a large, sweeping "E" and a long, horizontal flourish at the end.

Eric J. Figueroa